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Sang Won Park

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LADAS & PARRY LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1600
CHICAGO, IL 60604

EXAMINER

UBER, NATHAN C

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,956	Applicant(s) PARK ET AL.	
	Examiner NATHAN C. UBER	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 20 August 2008.
2. Claims 1-4, 6-11, 13-20 and 22 have been amended.
3. Claims 23-25 have been added.
4. Claims 1-25 are currently pending and have been examined.

Drawings

5. The drawings were objected to as failing to comply with 37 CFR 1.84(p)(4) and failing to designate figures 1 and 11 as –Prior Art-. Applicant's amendments are accepted. The objections are withdrawn.

Specification

6. The abstract of the disclosure was objected to because it contained self evident clauses and legal Phraseology. Applicant sufficiently amended the abstract. The objection is withdrawn.
7. The previous objections to the specification including the objections to the use of trademarks in the specification and the use of embedded hyperlinks in the specification are withdrawn.

Claim Objections

8. Claims 8, 13, 14 and 18 were objected to because they contained improper reference to claim 1. The claims have been sufficiently amended, the objection is withdrawn.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

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and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 8, 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 8, 13 and 14 presently recite *evaluation data* and Applicant argues on at least page 27 of the Applicant's remarks, that this limitation distinguishes Applicant's invention over the prior art. However *evaluation data* is absent from both the original disclosure and the currently amended specification, which was amended to clarify language translation issues. Further Applicant fails to indicate where the original specification shows support for this limitation. Examiner notes that Applicant does indicate a location in the amended specification to show support for this limitation, but that citation does not disclose *evaluation data* specifically. Applicant is reminded that MPEP §2111 instructs that the broadest reasonable interpretation is to be applied to claim language and limitations from the specification are not to be read into the claims absent a clear and explicit definition. In this case Applicant's specification does not support the narrow reading of *evaluation data* that Applicant suggests in Applicant's remarks.
11. Claims 1-22 were rejected under 112 2nd paragraph in the previous action. This rejection is hereby withdrawn because the antecedent basis and indefinite-"more than one among"-language was corrected by amendment. With regard to the previously cited indefinite terms, these terms were removed rendering the rejection moot.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 13. Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
- 14.** Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Nam et al. (WO 02107030 A1).

Claim 19:

Nam, as shown, discloses the following limitations:

- *a keyword database for recording multiple keywords, type information of the keyword, predetermined reference information that corresponds to the type information, advertisement list information that corresponds to the keyword, in which the advertisement list information includes a number of advertisement files that include the keyword (see at least Figure 1 , Item 118),*
- *a communication part for receiving a predetermined event from a user (see at least Figure 1 , Item 111),*
- *a processing part for recording a keyword as history data that corresponds to the received predetermined event from the user, searching for the type information of the keyword and the predetermined reference information that corresponds to the type information of the keyword by referring to the keyword database, and determining whether the keyword is an interested field of the user according to the predetermined reference information and*

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type information of the keyword searched in the keyword database (see at least Figure 1, Item 115),

- *an advertisement file preparing part for extracting the keyword determined to be the interested field of the user and generating an advertisement file including the extracted keyword, in which the advertisement file includes at least one of a user's terminal number (PC ID), an identifying symbol of the user, and expiration date information of the advertisement file (see at least Figure 1, Item 116),*
- *an advertisement information generating part for updating a number of advertisement files in the advertisement list information stored in the keyword database and generating advertisement information including the keyword and the advertisement list information updated with the number of advertisement files (see at least Figure 1, Item 119),*
- *an advertisement database for storing multiple keywords and multiple advertisement data that corresponds to the keyword (see at least Figure 1, Item 118),*
- *an advertisement transmitting part for processing the advertisement data that corresponds to the keyword included in the advertisement file by referring to the advertisement database, and providing the advertisement data that is processed to a web browser of the user (see at least Figure 1, Item 112),*
- *a storing part for storing history information with respect to the providing of the advertisement data to the user (see at least Figure 1, Item 118),*
- *an analyzing part for providing predetermined feedback information to a sponsor who has registered the advertisement data, according to the history information (see at least Figure 1, Item 116).*

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15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 1-7, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 02107030 A1) in view of Cohn et al. (US 6,308,202 B1). Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 02107030 A1) in view of Cheung et al. (U.S. 7,043,471 B2) and in view of Cohn et al. (US 6,308,202 B1).

Claims 1, 18, 23, 24 and 25:

Nam, as shown, discloses the following limitations:

- *maintaining a keyword database for recording multiple keywords, type information of the keyword, predetermined reference information that corresponds to the type information, and advertisement list information that corresponds to the keyword, in which the advertisement list information includes a number of advertisement files that include the keyword (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),*
- *receiving a predetermined event from a user (see at least Figure 3, Item 304),*

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- *recording a keyword as history data that corresponds to the received predetermined event, from the user (see at least page 3, line 20, storing characteristics of a site in a cookie),*
- *searching for the type information of the keyword by referring to the keyword database (see at least page 3, line 21, the information stored in the cookie may include key words, see page 3, line 25),*
- *searching for the predetermined reference information that corresponds to the type information of the keyword (see at least page 3, line 26),*

Nam does not specifically disclose the following limitations. However Cohn, as shown, discloses the following limitations:

- *determining whether the keyword is an interested field of the user in view of the predetermined reference information (see at least Figure 4, Items 120 and 160, this invention determines the keywords based on the url a user requests from the browser),*
- *generating an advertisement file including the keyword that is determined to be the interested field of the user (see at least Figure 4, Item 180),*
- *updating a number of advertisement files in the advertisement list information stored in the keyword database (see at least Figure 4, Items 150 and 170, the invention determines if keywords from the address pointer or ad information have been categorized and if not updates the system to categorize them),*
- *generating advertisement information including the keyword and the advertisement list information updated with the number of advertisement files (see at Figure 4, Item 180),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the categorizing method of targeting advertisements of Cohn with the advertising methods of Nam because Nam teaches selecting advertisements

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"depending on user's fields of interest and the characteristics of a web page" (Abstract). Further it would have been obvious to one having ordinary skill in the art at the time the invention was made since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 2:

The combination Nam/Cohn discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitation:

- *the predetermined event is one among a keyword inputted at a search window of an Internet search engine by the user, a web page address inputted at an address window of a web browser by the user, and a hypertext markup language link selected on the web browser by the user (see at least page 3, line 12, inputting a website address).*

Claim 3:

The combination Nam/Cohn discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitation:

- *the type information of the keyword is a predetermined effective period set in advance for each keyword (see at least page 16, lines 18-20).*

Claim 4:

The combination Nam/Cohn discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitation:

- *the predetermined reference information is a number of times the predetermined event is inputted from the user during the predetermined effective period (see at least page 16, line 20-21).*

Claim 5:

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The combination Nam/Cohn discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitation:

- *the advertisement file is a cookie file (see at least page 12, line 20-21).*

Claim 6:

The combination Nam/Cohn discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitation:

- *the advertisement file includes at least one of a terminal number (PC ID) of the user, an identifying symbol of the user, expiration data of the advertisement file (see at least page 17, lines 5-8, identifying information of the user is stored).*

Claim 20:

The combination Nam/Cohn discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitation:

- *the advertisement list information additionally includes a number of impressions of a web page that corresponds to the keyword (see at least page 16, line 20-21).*

Claim 7:

The combination Nam/Cohn discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitation:

- *the advertisement information additionally includes a number of impressions of a web page that corresponds to the keyword (see at least page 16, line 20-21).*

- 18.** Claims 8, 10-17, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 02107030 A1) in view of Cheung et al. (US 7,043,471 B2).

Claim 8:

Nam, as shown, discloses the following limitations:

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- *maintaining a keyword database for storing multiple keywords and advertisement information according to the keywords* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),
- *receiving a first advertisement request that includes an advertisement keyword from a first sponsor, wherein the advertisement keyword corresponds to one of the multiple keywords stored in the keyword database* (see at least page 13, line 20-21, see also page 11, lines 5-25, advertising corresponds to the keywords, see also page 8, advertisement and corresponding key),
- *searching for the advertisement information that corresponds to the advertisement keyword by referring to the keyword database* (see at least page 3, line 26, see also page 11, lines 5-25, advertising corresponds to the keywords),
- *recording, in a first advertisement database, the advertisement keyword and the first advertisement data that corresponds to the advertisement keyword* (see at least page 3, line 20),

Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitations:

- *processing the advertisement information that corresponds to the advertisement keyword and providing evaluation data of the advertisement keyword to a web browser of the first sponsor* (see at least column 23, lines 22-55, "project expenses" feature of this invention predicts based on the advertisement keyword the response that an advertiser can expect, i.e. the number of clicks, and predicts the cost of the advertising campaign for the advertiser based on a cost per click payment scheme; Examiner notes that

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this prediction mechanism requires a determination of expected clicks based on previous data and keyword),

- *receiving a purchase response from the first sponsor, in which the purchase response includes first advertisement data of the first (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting and advertiser providing payment for the ad),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 10:

The combination Nam/Cheung discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitations:

- *wherein the evaluation data includes at least one of information for a number of generated advertisement files, information for a number of impressions of a web page corresponding to the advertisement keyword, price information of the advertisement keyword (see at least page 16, line 20-21).*

Claim 11:

The combination Nam/Cheung discloses the limitations as shown in the rejection above. Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitation:

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- *the purchase response additionally includes payment information for a predetermined advertisement charge* (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting and advertiser providing payment for the ad),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 12:

The combination Nam/Cheung discloses the limitations as shown in the rejection above. Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitation:

- *the advertisement request is performed in a manner of auction or bidding* (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through

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costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claims 13 and 14:

Nam, as shown, discloses the following limitations:

- *maintaining an advertisement database for storing multiple keywords and multiple advertisement data that correspond to the keywords* (see at least page 8, line 10-12, a database that may be indexed by "key" – note that this patent uses the phrase "key word" and "key" rather than keyword),
- *receiving an access request from a user, wherein the access request includes an advertisement file stored in a user's terminal* (see at least Figure 3, Item 304),
- *extracting a keyword recorded in the advertisement file received* (see at least page 3, line 21, the information stored in the cookie may include key words, see page 3, line 25),
- *searching for the advertisement data that corresponds to the keyword by referring to the advertisement database* (see at least page 3, line 26),
- *processing the advertisement data corresponding to the keyword and providing the same to a web browser of the user* (see at least page 3, line 26-27),
- *maintaining a keyword database for storing multiple keywords and advertisement information according to the keywords* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),
- *receiving an advertisement request that includes an advertisement keyword from a sponsor, wherein the advertisement keyword corresponds to one of the multiple keywords stored in the keyword database* (see at least page 13, line 20-21),

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- *searching for the advertisement information that corresponds to the advertisement keyword by referring to the keyword database (see at least page 3, line 26),*
- *recording, in the advertisement database, the advertisement keyword and the advertisement data that corresponds to the advertisement keyword (see at least page 3, line 20).*

Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitations:

- *processing the advertisement information that corresponds to the advertisement keyword and providing evaluation data of the advertisement keyword to a web browser of the first sponsor (see at least column 23, lines 22-55, "project expenses" feature of this invention predicts based on the advertisement keyword the response that an advertiser can expect, i.e. the number of clicks, and predicts the cost of the advertising campaign for the advertiser based on a cost per click payment scheme; Examiner notes that this prediction mechanism requires a determination of expected clicks based on previous data and keyword),*
- *receiving a purchase response from the first sponsor, in which the purchase response includes first advertisement data of the first (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting and advertiser providing payment for the ad),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is

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focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 14:

Nam, as shown, discloses the following limitations:

- *constructing a user interface screen by arranging the first advertisement data or the second advertisement data according to predetermined criteria* (see at least page 3, line 26-27, see also at least page 2, line 18, ads are displayed based on the ad table, i.e. the order),
- *providing the user interface screen to a web browser of the user* (see at least page 3, line 26-27, see also at least page 2, line 18, ads are displayed based on the ad table, i.e. the order).

Claim 15:

The combination Nam/Cheung discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitations:

- *maintaining a second advertisement database for storing multiple second advertisement data that corresponds to a predetermined keyword* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),
- *maintaining a third advertisement database for storing multiple third advertisement data* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),
- *receiving a second keyword from the user* (see at least page 11, lines 8-9),
- *searching for the second advertisement data that corresponds to the second keyword by referring to the second advertisement database* (see at least page 3, line 26),

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- *searching for the third advertisement data by referring to the third advertisement database (see at least page 3, line 26),*
- *constructing a user interface screen by arranging the advertisement data, the second advertisement data, and the third advertisement data according to predetermined criteria (see at least page 2, line 18, ads are displayed based on the ad table, i.e. the order),*
- *providing the user interface screen to the web browser of the user reference (see at least page 2, line 18, ads are displayed).*

Claims 16 and 21:

The combination Nam/Cheung discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitations:

- *the second advertisement data is general keyword advertisement data, and a third advertisement data is general banner advertisement data (see at least page 8, line 13, banner advertisement).*

Claims 17 and 22:

The combination Nam/Cheung discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitations:

- *providing predetermined feedback information to the sponsor, in which the feedback information includes at least one of the number of times the advertisement data is provided to the user, a number of times the user clicks on the advertisement data, a time period the user visits a web page of the sponsor, and a number of times the user visits the web page of the sponsor after the advertisement data is provided (see at least page 16, line 20- 21).*

- 19.** Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 2107030 A1) in view of in view of Cheung et al. (US 7,043,471 B2) and in view of Cohn et al. (US 6,308,202 B1).

Claim 9:

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The combination Nam/Cheung discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitations:

- *if there is no advertisement information corresponding to the advertisement keyword in the keyword database, recording the received advertisement keyword and an input counter value for the advertisement keyword in a predetermined storing means (see at least page 3, line 20),*
- *if a second advertisement request including the advertisement keyword is received from a second sponsor, increasing the input counter value for the advertisement keyword recorded in the storing means (see at least page 13, line 20-21),*
- *if the input counter value is greater than the predetermined value, recording, the advertisement keyword and advertisement information that corresponds to the advertisement keyword in the keyword database (see at least page 3, line 20),*

Nam does not specifically disclose the following limitations. However, Cohn, as shown, discloses the following limitation:

- *determining whether the input counter value is greater than a predetermined value (see at least Figure 4, Items 120 and 160, categorize the address pointer, this invention determined the keywords based on the url a user requests from the browser),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

20. Applicant's arguments with respect to claims 8, 10-17, 21 and 22 have been considered but are moot in view of the new grounds of rejection.
21. Applicant's arguments with regard to claim 19 filed 20 August 2008 have been fully considered but they are not persuasive. Applicant argues that the citations used by examiner to show that the structural components of Applicant's invention are insufficient because the citations fail to disclose the "processes" that Applicants claimed structural components are used for (see page 32 of Applicant's arguments). Specifically Applicant points to Examiner's treatment of the *processing part* limitation. Claim 19 is a system claim which is directed to structural components. The limitation that is the subject of Applicant's argument discloses "a processing part for..." Examiner cited one structural feature in Nam that corresponds to a processing part, which Examiner notes is a very broad limitation. Whether or not Nam discloses what its processor is used for is moot, because patentable weight is not given to limitations directed to the intended use of structural components (see MPEP § 2106). Further, although in the context of describing structural features Examiner did not find it necessary to show Applicant where the intended-use-limitations are taught by the prior art of record, the limitations in question are substantially repeated elsewhere in Applicant's claim set and in the context of a method they were given patentable weight and appropriate citations were made. Examiner reminds Applicant that although Examiner points out specific citations in the art of record that teach various limitations, this is only done as a courtesy and is not intended to mean that those citations are the only citations in the prior art of record that appropriately address Applicant's claims, rather Applicants are encouraged to consider the entirety of the prior art of record.
22. Applicant's arguments with regard to claims 1-7 and 20 filed 20 August 2008 have been fully considered but they are not persuasive. Applicant first argues that "Nam does not teach a keyword database for storing --type information of the keyword-- or --predetermined reference information..." (see at least page 33 of Applicant's arguments). The crux of Applicant's argument is over a lack of a specific teaching in Nam of the various types data stored in Applicant's

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database. However, Nam does teach maintaining a database that is capable of storing data, which is the only positively recited element of the limitation. The type of data that can be stored in a database is merely non-functional descriptive material in this instance (see MPEP § 2106). Examiner maintains that Nam's teaching of a database can store any type of data. Further Applicant's specification lacks specific definitions of various terms, as Examiner pointed out in the previous Office action with a series of 112 2nd rejections. Applicant presently argues narrow definitions for broad claim language such as "type information" and "predetermined reference information," but Applicant is reminded that MPEP §2111 instructs that the broadest reasonable interpretation is to be applied to claim language and limitations from the specification are not to be read into the claims absent a clear and explicit definition. In this case Applicant's specification does not support the narrow reading of "type information" and "predetermined reference information" that Applicant suggests in Applicant's remarks.

23. Next Applicant argues that the Cohn reference does not teach Applicant's invention because "examiner's characterization of the term *judging*... is completely incorrect" and further that Cohn does not teach "determining whether the keyword is an interested field of the user." Whether or not Examiner properly interpreted the term *judging* is moot because the term has been removed from both the claims and the specification and replaced with *determining*. However, determining is also a broad term and it is not specifically defined. Examiner maintains that the Cohn reference teaches the claims based on a reasonable interpretation of Applicant's broad claim language. Applicant also stresses that Cohn does not disclose determining an "interested field of the user." This term appears at least 56 times in the specification, but it is never explicitly defined. Examiner assumed that this term at least embraces a search term, or a term that a user inputs, which is a concept that is taught by Cohn. Examiner does not believe that this term is indefinite as one having ordinary skill in the art would recognize that any input a user provides to a search engine or to a navigation field of a web browser constitutes items of interest to the user. However, if Applicant intends a different more narrow definition, that definition is lacking from both Applicant's specification and Applicant's arguments.

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- 24.** Further with regard to the examiner's assertion of official notice in the prior Office action, Examiner indicates that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. Examiner amended the relevant rejection as necessitated by Applicant's amendments, but maintains and repeats the well-known in the art statement below: *Examiner takes **Official Notice** that it is old and well known in the art to transfer payment information to a service provider.*

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Conclusion

- 25.** Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Further all arguments regarding claim rejections that are maintained have been addressed above. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- 26.** A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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27. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
29. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

30. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
17 December 2008

/Arthur Duran/
Primary Examiner, Art Unit 3622